

REMARKS

In the Official Action, the Examiner rejected claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47 and 49. Applicants respectfully request reconsideration of the application in view of the remarks set forth below. Applicants believe that all pending claims are in condition for allowance.

Election Requirement

Applicants acknowledge the election of claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47, and 49, as well as the withdrawal of the remaining pending claims. Applicants further acknowledge that once allowable subject matter is determined, all of the species identified in the withdrawn claims may also be allowed.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 5, 9, 16, 23, 30, 33, 40 and 47 under U.S.C. § 102(e) as being anticipated by Emerson et al. (U.S. Patent No. 6,476,854, hereafter "the Emerson reference"). Additionally, the Examiner rejected claims 1, 5, 9, 16, 28, 30, 33, 40 and 47 under 35 U.S.C. 102(e) as being anticipated by Rao et al. (U.S. Patent No. 6,321,287, hereafter "the Rao reference"). The Examiner stated:

5. Claims 1, 5, 9, 16, 23, 30, 33, 40 & 47 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Emerson et al. (6,476,854).

- a. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

- b. In figure 1 and the respective description sections teaches all of the claimed limitations; therefore, the claimed invention would have been clearly anticipated by the Emerson reference. It appears that the one of the common inventor should know the details teachings of the Emerson reference; therefore, no details teachings deem necessary. Furthermore, one skilled in the art should know the same teachings of Emerson reference an the claimed invention.

6. Claims 1 , 5, 9, 16, 28, 30, 33, 40 & 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Rao et al. (6,321,287).

- c. Rao teaches all of the limitations of the claims as follows:

Claims 1, 5, 9, 16, 23, 30, 33, 40 & 47, Rao et al.

- a computer system, comprising
 - Feature of figure 1
- Expansion slot
 - Feature of slots that receives (301)-
- Managed computer system
 - Feature of (101) above and right of (121)
- a bus for interconnecting a managed computer system with an expansion slot;
 - feature of PC1 BUS (120), figure 1
- an expansion board comprising a processor, the board disposed in the expansion slot; and
 - feature of figure (301)
- a processor
 - feature of Controller (205) of figure 3
- a remote console functionality assist logic structure controlled by the processor to provide video signals generated by the managed computer system to a remote computer system.
 - Feature of (121,123,131 ,I 33), figure 1

- d. Since the Rao reference teaches all of the limitations of the claims, the claimed limitations would have been anticipated by the teachings of the Rao reference.

Office Action, pages 3-5.

Applicants respectfully traverse this rejection. Applicants have amended the priority claim in the present application to claim priority to, *inter alia*, the Emerson patent, which was filed on October 18, 1996. As can be seen from the attached Petition to Claim Priority Under

37 C.F.R. § 1.78(a)(3), the entire delay between the date the priority claim was due under Rule 78(a)(2)(ii) and the date the priority claim was filed was unintentional. Entry of the amended priority claim will remove both the Emerson reference and the Rao reference. Accordingly, Applicants respectfully request entry of the priority claim, withdrawal of the Examiner's rejections, and allowance of all pending claims.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 3, 7, 14, 21, 25, 38, 45 and 49 under 35 U.S.C. § 103(a) as obvious over the Rao reference.

9. Claims 3, 7, 14, 21, 25, 38, 45 & 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al. (6,321,287).

- e. The teachings of the parent claims I, 5, 9, 16, 23, 30, 33, 40 & 47 are similarly applied in this rejection.
- f. As for claims 3, 7, 14, 21, 25, 38, 45, 49, the Rao reference does not expressly disclose the limitation regarding the video encoder being part of the remote console; however, this is an well known design choice matter that are commonly practiced in the art of video processing art. The present application pages 14-15 & 23 also support the video encoder is provided, as "an enhancement, although it is not essential", "is generally provided for enhanced functionality such as video playback, etc". One skilled in the art can easily add such functional enhancement when desired. See also cited references Potu et al. (5,812,144) and Stephenson et al. (6,134,613), as an example. Therefore, it would have been obvious at the time the invention was made to one having ordinary skill in the art to add such commonly known -commonly practiced enhancement to the Rao's system for the well-known motivation of functionally enhancement such as video playback, etc.

Office Action, pages 5 and 6.

As mentioned above, entry of the amended priority claim will remove the Rao reference from consideration. Accordingly, Applicants respectfully request entry of the

amended priority claim, withdrawal of the Examiner's rejection, and allowance of all pending claims.

Double Patenting Rejection

The Examiner has indicated that claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47 and 49 are rejected on the ground of nonstatutory double patenting over claims 1-32 of U. S. Patent No. 6,742,066 (Emerson et al.) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. Additionally, Claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47 and 49 are rejected on the ground of nonstatutory double patenting over claims 1-6 of U. S. Patent No. 6,385,682 (Emerson et al.) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Although Applicants do not necessarily agree with the Examiner's rejections, the filing of terminal disclaimers will not shorten the term of a patent issuing from the present application, and there is no intention to divide ownership in any event. Accordingly, Applicants hereby submit properly executed terminal disclaimers to obviate the Examiner's rejections.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

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